

Remarks

Claims 1-14 and 16-44 have been deleted without prejudice. Claim 15 has been amended and claims 45-58 have been added.

This application incorporates by reference U.S. Patent Application Serial No. 07/669,862, filed March 15, 1991, which is a continuation-in-part of abandoned U.S. Patent Application Serial No. 07/555,274, filed July 19, 1990 and a continuation-in-part of U.S. Patent No. 5,075,222, issued December 24, 1991 (see e.g., the present specification at Page 1, first paragraph). The present claims are entitled to the benefit of priority of at least the filing date of U.S. Patent Application Serial No. 07/669,862. Applicants are not at this time submitting a substitute specification. In the event a patent issues from one of the copending applications of U.S. Patent Application Serial No. 07/669,862, Applicants need not submit a substitute specification containing the subject matter incorporated by reference. If a patent has not issued from one of the copending applications at the time the present application is otherwise allowable, Applicants can submit a substitute specification containing the subject matter incorporated by reference. Unless the Examiner informs Applicants otherwise, Applicants' attorney assumes that this will be acceptable to the Patent Office. Amended claim 15 and new claims 45 to 58 are fully supported by the teachings, including the sequence of the 30 kDa TNF inhibitor in Figure 2, of U.S. Patent Application Serial No. 07/669,862 as originally filed. Accordingly, the pending claims do not add new matter.

Discussion

Restriction Requirement under 35 U.S.C. §121

Claims 1-14 and 34-43 are drawn to a non-elected invention and have been deleted without prejudice.

Change of Inventorship

Claim 15 has been amended and new claims 45 to 58 have been added, each claim enjoying priority from at least the filing date of United States Patent Application Serial No. 07/669,862, filed March 15, 1991, entitled "Pegylation of Polypeptides". The listed inventorship shall now be, in addition to Hiko Kohno, one or more of Robert C. Thompson, Lyman G. Armes, Ronald J. Evans and Michael T. Brewer. Applicants' attorney is in the process of preparing the appropriate documents and obtaining necessary signatures to amend inventorship according to 37 C.F.R. §1.48(b).

Copending Applications

Applicants desire to bring the following copending applications to the attention of the Examiner. The following application, entitled "Pegylation of Polypeptides", in the names of Robert C. Thompson, Lyman G. Armes, Ronald J. Evans, Michael T. Brewer and Tadahiko Kohno, U.S. Patent Application Serial No. 08/482,283, filed June 7, 1995. The following additional applications, each entitled "Pegylation Reagents and Compounds Formed Therewith", in the names of Milton Harris, Tadahiko Kohno and Dave Kachensky: U.S. Patent Application Serial Nos. 08/482,284, filed June 7, 1995; 08/484,783, filed June 7, 1995 and 08/485,441, filed June 7, 1995.

Each of the inventors of Serial No. 08/482,283 had an obligation to assign his rights to Synergen, Inc. on the date of the invention; and inventors Tadahiko Kohno and Dave Kachensky of U.S. Patent Application Serial Nos. 08/482,284, 08/484,783 and 08/485,441 each had an obligation to assign his rights to Synergen, Inc. on the date of the invention; inventor Milton Harris of 08/482,284, 08/484,783 and 08/485,441 did not have an obligation to assign his rights to Synergen, Inc. on the date of the invention. In 1995, Synergen, Inc. became a subsidiary of Amgen Inc., and was subsequently renamed Amgen Boulder Inc. On December 31, 1997, Amgen Boulder Inc. was merged with and into Amgen Inc., under the name of Amgen Inc.; that name change has not yet been recorded at the U.S. Patent and Trademark Office.

Rejection of Claims 15-33 and 44 under 35 U.S.C. §112, second paragraph

Claims 15-33 and 44 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In view of the amendment to Claim 15, the questions raised by the Examiner regarding the scope of "X", "R₂", the "second reactive group" as well as the bonding of "R₂" with the second reactive group are rendered moot with respect to the pending claims.

Rejection of Claims 15-33 and 44 under 35 U.S.C. §112, first paragraph

Claims 15-33 and 44 stand rejected under 35 U.S.C. §112, first paragraph, as being non-enabled by the specification.

In view of the amendment to Claim 15, the present rejection is rendered moot with respect to the pending claims.

Rejection of Claims 15, 17-19, 22, 31-33 and 44 under 35 U.S.C. §102(b)/103(a)

Claims 15, 17-19, 22, 31-33 and 44 stand rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 USC 103(a) as being obvious over Shaw et al. U.S. 5,166,322.

In view of the amendment to claim 15, the pending claims are neither anticipated by nor rendered obvious by the teachings of Shaw et al. Accordingly, the rejection is rendered moot.

For the foregoing reasons, the present application is in condition for allowance, and an early notification to that effect is earnestly solicited.

Respectfully submitted,



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